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Applicant	:	Sepehr Fariabi	
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Art Unit	:	3774	
Examiner	:	Paul B. Prebilic	
Title	:	HIGH STRENGTH MEMBER FOR INTRACORPOREAL USE	
Docket No.:	:	ACSG-66757	
Customer No.	:	24201	October 30, 2009

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REPLY BRIEF

This Reply Brief is responsive to the Examiner's Answer mailed August 31, 2009 in the appeal from the Office Action mailed October 31, 2008. This Reply Brief is being filed within the term provided as permitted under 37 C.F.R. § 1.193(b)(1), and is in compliance with 37 C.F.R. § 41.37.

ARGUMENT

GROUND I:

The Examiner now argues that claim 52 does not positively require the stent to be formed of an alloy that requires the stent to undergo plastic deformation in order to attain its expanded state within a coronary artery because it merely requires the stent to have an interior chamber "configured to receive an expandable member for plastically expanding the stent from a first low profile delivery configuration to a second radially expanded configuration, the second radially expanded configuration having a diameter to hold open a coronary artery." However, such configuration clearly requires the stent to be formed of such an alloy because it is such characteristic of the alloy that dictates the interior chamber configuration. If the alloy were not deformable by plastic deformation to attain its expanded state within a coronary artery, the inner chamber configuration would be immaterial as it could not possibly be configured to impart such characteristic to the stent. On the other hand, it is positively required for the material to be plastically deformable in order to provide an interior chamber configuration which allows the stent to be expanded, by plastic deformation, within an artery to a diameter suitable for supporting such artery.

The Examiner goes on to argue that "the other 10 independent claims do not **exactly** require the stent to undergo plastic deformation in order to attain its

expanded state within a coronary artery" but merely require the stent to be **plastically deformable** from the first to the second configuration. While requiring the stent to actually undergo the plastic deformation would comprise the claiming of a use, the claiming of a characteristic comprises a structural limitation. Moreover, such structural limitation is what effectively avoids the cited art in view of the fact that such art does not suggest a stent that is plastically deformable as per the claims. A stent that is plastically **deformable** as claimed avoids the prior art even if it is never deformed, i.e. used.

After raising the argument that the **claims** do not "exactly require the stent to undergo plastic deformation", i.e. its use, the Examiner next objects to the Appellant's **argument** as to the use of the stent. However, while the claims require a distinguishing **structure** (as claimed) the non-obviousness of such structure can clearly be supported by how it is used or how it is usable. The Examiner goes on to assert that "one could reasonably utilize the Robinson device in a coronary artery where the device is sized to expand as set forth in some of the claims." There is however no support for such assertion. Because the Robinson device is clearly subject to elastic deformation, it must initially be expanded to the limit of its elasticity before it can undergo any plastic deformation. After it has been expanded by plastic deformation, it will relax to a smaller diameter so as to recover from its initial elastic deformation. In order for the stent to relax from its initial

elastic deformation to a diameter **suitable** for supporting a coronary artery, it would have had to have been expanded well beyond the diameter of the coronary artery, regardless of the actual size of the artery, and thereby preclude its use within such artery as is claimed.

The Examiner's interpretation that the device of Robinson could achieve an expanded state in which the bends (37) of Figure 4 were completely unbent is similarly unfounded. In view of the fact that the reference unequivocally teaches that the stent is elastically deformable, a completely unbent configuration could only be achieved if each bend were to be bent beyond 180 degrees so that a 180 degree (unbent) configuration is achieved after the material relaxes from its elastically expanded state. The Examiner offers no mechanism as to how such deformation is achievable within a coronary artery as is claimed.

The Examiner then restates his position that that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. There is clearly a structural difference to the extent that the claims require the stent to be **configured** so as to be plastically deformable to an expanded state suitable for supporting a coronary artery while the cited art is **not configured** to be plastically deformable to an expanded state suitable for supporting a coronary artery. The Appellant would reiterate that it is this structural

difference that results in two mutually exclusive intended uses, wherein the prior art structures cannot be used in balloon expandable applications as set forth above while the claimed structure cannot be used in self-expanding applications. The Appellant is in full agreement with the Examiner's assertion that if the prior art structure is capable of performing the intended use, then it meets the claim. Because structure of the cited art is in this case not capable of performing the intended use, it does not meet the claim.

Finally, the Examiner argues that the **claims** fail to teach the specific ratios of components and particular treatments that result in this "alleged" property. It is respectfully submitted that it is the **specification** rather than the claims that must be relied upon to teach an invention. The claims merely lay claim to the invention without limitation to **specific** ratios and **particular** treatments as is demanded by the Examiner. The specification teaches how cold-working stages, tensioning, annealing, age hardening, etc imparts plastic deformability to what the Examiner characterizes as "substantially the same material composition" which the cited art teaches as being elastically deformable. As such, the specification teaches how this is achieved. Since the prior art teaches that "substantially the same material compositions" are elastically deformable while the specification describes how these materials are rendered plastically deformable, the specification serves as the evidence of the difference. The claims only claim the end result, i.e. those states of

the claimed alloys that are plastically deformable. The position taken by the Examiner that plastic deformation properties as claimed would be **inherent** in "substantially the same material composition utilized by Robinson" flies in the face of the unequivocal teachings of the Robinson reference that such material compositions are inherently elastically deformable. Moreover, it underscores the non-obviousness of the construction of a **balloon expandable** stent with what the Examiner characterizes as "substantially the same material composition."

GROUND II

The Appellant relies on the arguments present againt the first ground of rejection so these claims stand or fall therewith.

GROUND III

The Appellant relies on the arguments present againt the first ground of rejection so these claims stand or fall therewith.

CONCLUSION

For the foregoing reasons, it is maintained that the present invention as claimed is not obvious over cited art and that the Examiner's rejections of claims 37-85 were therefore erroneous. Accordingly, appellant respectfully requests reversal of the rejection of claims 37-85.

The commissioner is authorized to charge any deficiencies in fees or credit any overpayments to our Deposit Account No. 06-2425.

Respectfully submitted,

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